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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,159	10/20/2003	Kevin L. Kimle	P03566US01	6394
22885	7590	11/28/2006	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			TRAN, HAI	
			ART UNIT	PAPER NUMBER
			3693	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/689,159

Applicant(s)

KIMLE ET AL.

Examiner

Hai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/27/04</u>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Objections*

1. Claim 17 is objected to because of the following informalities: The phrase "The variable can is" appears to be incorrect. Appropriate correction is required.

### *Double Patenting*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 15 and 24-38 of US Patent No. 7,124,108 to Kimle et al. since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art. Claims 1-28 in the instant application essentially repeat the features in the claims of the patent with minor modification:

- a) Claims 1-12 are disclosed in claims 1-12 of the patent except that claim 1 of the instant application has a minor modification;
- b) Claims 13-23 are disclosed in claims 24-34 of the patent except that claim 13 of the instant application has a minor modification;
- c) Claim 24 is disclosed in claim 15 of the patent; and
- d) Claims 26-28 are disclosed in claims 36-38 of the patent except that claim 26 of the instant application has a minor modification.

The table below is presented to show how the claims in the instant application correspond with those in the patent; however, only the rejection of claim 1 of the instant application is specifically explained below as exemplarily to how the other claims are also rejected.

<u>Application Claim Number</u>	<u>Patent 7,124,108</u>
1-12	1-12
13-23	24-34
24	15
25	35
26-28	36-38

Claim 1 of this application is rejected under the judicially created doctrine of "obviousness-type" double patenting over exemplar claim 1 of US Patent No. 7,124,108. A rejection based upon "obviousness-type" double patenting is based upon the judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by the patent no matter how the extension is brought about and has, as its basis, the principles now well-established in Office practice, enunciated in In re Lonardo, 43 USPQ 2d 1262 (Fed. Cir. 1997); In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993); In re Berg, 6 USPQ 2d 1226 (Fed. Cir. 1998); In re Lilly, 58 USPQ 2d 1865 (Fed. Cir. 2001); In re Longi, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 214 USPQ 761 (CCPA 1982); In re Vogel, 164 USPQ 619 (CCPA 1970); and In re Thorington, 163 USPQ 644 (CCPA 1969).

Initially, it should be noted that:

- a) the instant application is a voluntarily filed application that may be related to application serial No. 09/335,648, now Patent No. 7,124,108;
- b) the filing of the instant application was not necessitated by a restriction requirement;
- c) there is a common relationship of inventorship and ownership of the patent and application (Kimle et al. is the inventor and owner in both the patent and application);
- d) there is common disclosure supporting the application claims and the patent claims; and
- e) this is not a case of an improvement or modification invented after filing of the parent application.

As stated previously, the rule against double patenting seeks to prevent the unjustified extension of the right to exclude granted by a patent. Thus, the question to be answered is whether or not the subject matter covered by claim 1 of the patent would have its term extended if claim 1 in this application is patented. A side-by-side comparison of exemplary patent claim 1 with application claim 1 shows the following: Patent claim 1 and application claim 1 are directed to the same subject matter, i.e., a method of facilitating a contract of agricultural commodities using the Internet comprising: providing a Web server, a centralized database system for storing data, responding, receiving data and generating contract. However, application claim 1 differs from exemplary patent claim 1 in that the application claim has been:

- a) broadened by reciting that the method "providing a centralized database system for the storage and retrieval of data" as opposed to "providing, in operative communication with the server, a centralized database system for the storage and retrieval of data including data related to types or amounts of an agricultural commodity";
- b) broadened by reciting "storing data in the database relating to types and amounts of agricultural commodities desired by one or more agricultural commodity buyers" as opposed to "storing data in the data base relating to types and amounts of agricultural commodities desired by one or more potential agricultural commodity buyers and establishing a defined allocation of an amount of a type of agricultural commodity according to at least one allocation parameter, where at least one of the at least one allocation parameter is set to reduce risk associated with future contracting of agricultural commodities";
- c) broadened by eliminating the (e) restriction of the patent "in response to input from a buyer or supplier, designating a specific contract program"; and
- d) broadened by replacing the (g) (h) and (i) restrictions of the patent with the requirement of "generating a contract for the sale of the specific type and amount of the commodity by the supplier to the buyer".

Thus, upon overlaying application claim 1 onto patent claim 1, it is clearly evident that application claim 1 encompasses subject matter previously claimed in patent claim

1. As it is noted in above, i.e., In re Goodman, supra, In re Berg, supra, In re Lilly,

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supra, and In re Lonardo, supra, set forth the doctrine of "obviousness-type double patenting" as follows:

- 1) Goodman - a later genus (broader) claim is not patentable over an earlier species (narrower) claim;
- 2) Berg - rejection of genus (broad) claims in a later patent application for obviousness-type double patenting proper in light of species (narrower) claims in an earlier patent;
- 3) Lonardo - invalidates claims in a later patent under doctrine of obviousness type double patenting where "alleged differences in elements are in species-genus form," with the earlier patent claiming elements more specifically and the later patent claiming elements more generally; and
- 4) Lilly - affirms that a later patent claim is not patentable over an earlier patent claim when a recited limitation in the later claim is an inherent characteristic, i.e., "a natural result" flowing from the reference's explicitly explicated limitation.

Comparing the application claim changes (noted hereinabove) relative to the patent claim by considering corresponding individual limitations and applying the appropriate rationale in Goodman, Berg, Lonardo and Lilly, the following analysis is appropriate:

- 1) application method claim 1 (genus) anticipated by patent method claim 1 (species) for reasons set forth in the Goodman, Berg and Lonardo decisions; and



Accordingly, the differences in subject matter between exemplary patent claim 1 and application claim 1 are such that the claims are not patentably distinct, i.e. the claims are deemed to merely obvious variations. Therefore, claim 1 is rejected under the judicially created doctrine of "obviousness-type" double patenting over claim 1 of US Patent No. 7,124,108 to Kimle et al. since the claim, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Claim 1 is similar to method claims 13, 24, 25 and 26, which are disclosed in the circumstance similar to that of claim 1. It would be obvious to one of ordinary skill in the art that these claims have similar limitation. Therefore, claims 13, 24, 25 and 26 are rejected under the same explanation provided regarding claim 1.

Claims 2-12, 14-23, and 27-28 are the dependent claims for independent claims 1, 13 and 26 respectively. It would be obvious to one of ordinary skill in the art that these claims also have similar limitation. Therefore, they are rejected under the same explanation provided regarding claim 1.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
5. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully

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consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7364. The examiner can normally be reached on M-F, 8-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Tramell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT.

  
ELLA COLBERT  
PRIMARY EXAMINER